AF/2122
2700$
CC
#14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William S. Johnson

Serial No. 09/560,473

Filed: 04/28/2000

For: **SOFTWARE DOWNLOAD SYSTEM AND METHOD FOR AUTOMATIC RETRIEVAL OF ROYALTY, WARRANT, AND COMMISSIONING DATA**

Examiner: Kiss, Eric B.

Art Unit: 2122

RECEIVED

NOV 0 4 2003

Technology Center 2100

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present **APPEAL BRIEF** is filed in triplicate pursuant to 37 C.F.R. § 1.192. Applicant also encloses a credit card form authorizing payment in the amount of $440.00 for the appeal brief and a one month extension of time as required by 37 C.F.R. § 1.17(c) and 37 C.F.R. § 1.17(a)(1), respectively. If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The present application is owned by Gilbarco Inc. of 7300 W. Friendly Avenue, Greensboro, North Carolina 27410, which is a subsidiary of Danaher Inc.

(2) RELATED APPEALS AND INTERFERENCES

U.S. Patent Application Serial No. 09/611,087 is concurrently being appealed. These applications share similar subject matter, the same Examiner, the same references, and have many of the same issues.

(3) STATUS OF CLAIMS

Claims 1-38 have been presented and rejected, with the rejection made final.

(4) STATUS OF AMENDMENTS

Applicant filed an amendment after the final rejection on July 08, 2003, which has not been entered. As this amendment only fixed a typographical error in the preamble of claim 1, Applicant believes that it did simplify issues for appeal. However, as noted, this amendment has not been entered as of the filing of this Appeal Brief.

(5) SUMMARY OF THE INVENTION

The present invention is directed to a system that updates software in fueling environments. Specifically, the software is generated at a corporate site (200), such as a fuel dispenser manufacturer. The software is installed (or was created) on the corporate computer (202). From the corporate computer (202), the software is conveyed to a portable computing device (206). The portable computing device (206) is issued to an Authorized Service Contractor (ASC). Upon the request of a fueling site, the ASC is dispatched to the fueling site with the portable computing device (206). Once at the fueling site, the ASC connects the portable computing device (206) to a computer within the fueling site. This computer may be a site controller (150) or a fuel dispenser, but is most likely the site controller (150). The portable computing device (206) then queries the site controller (150) as to the number and type of computing devices with which the site controller (150) communicates. Additionally, the portable computing device (206) determines what version of what software is running on each of the computing devices so located. Collectively, this information can be considered a "topology" of the fueling site. The topology is stored in a record in the portable computing device (206).

Based on the information provided to the portable computing device (206), the portable computing device (206) can determine if the requested upgrade is compatible with the hardware and software currently active in the fueling site. If the requested upgrade is compatible with the currently active hardware and software, the portable computing device (206) uploads the upgrade to the site controller (150), the fuel dispensers (10), or other computing devices as needed. Additionally, if the requested upgrade could be compatible if used in conjunction with a patch, then the patch is uploaded so as to enable the upgrade. It is possible to upload the software to the fuel dispensers (10) or other computing devices through the site controller (150). After the upgrades are installed, the portable computing device (206) records the number and type of upgrades that have been provided. The number and types of upgrades provided is appended to

the record with the topology. Additionally, the ASC may enter a record of any service or maintenance performed at the fueling site that is independent of the upgrades.

The ASC periodically returns to the corporate computer (202) and connects the portable computing device (206) thereto. The portable computing device (206) uploads the records stored therein to the corporate computer (202), including topology records, with appended upgrades and service or maintenance records created by the ASC. The corporate computer (202) can assemble a database from these records that lists the topologies of each fueling site. From this information, the corporate entity may arrange to bill the fueling site and provide commissions to the ASCs for the work performed. Royalty payments may also be calculated for third party software vendors. Furthermore, the database so assembled may be mined to provide recommendations about upgrades that may benefit particular fueling sites.

(6) ISSUES

1) The amendment after final should have been entered since it simplified issues.

2) Claims 1-38 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of co-pending application No. 09/611,087.

3) Claims 1-7, 10-16, 27, and 29-38 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac et al. in view of Finley et al.

4) Claims 8, 9, 17-26 and 28, were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac et al. in view of Finley et al. and further in view of Fisher et al.

(7) GROUPING OF CLAIMS

Claims 1-7, 10, 11, 27, and 29-38 stand or fall together.

Claims 12-16 stand or fall together.

Claims 8, 9, 17-26, and 28 stand or fall together.

(8) ARGUMENT

Amendment After Final

Applicant attempted to file an amendment after the final rejection to correct a typographical error in claim 1. This amendment introduced the word "to" in the preamble of the claim. It is Applicant's position that the coherency of the claim suffers without the word "to."

While the Patent Office has not raised this issue in this case, there are some Examiners in the Patent Office that feel that such grammatical errors are sufficient to issue a rejection under 35 U.S.C. § 112 on the grounds that the claim is indefinite. By preemptively addressing this issue, Applicant forestalls such a rejection being issued. To this extent, the amendment simplifies issues and should have been entered.

The amendment should also have been entered on the grounds that it does not cause an undue burden on the Patent Office. No material change has been made to the claim; no new search is required; and the amendment makes the claim easier to read. To this extent, there is no reason not to enter the amendment. Applicant requests that the Examiner consent to the entry of this amendment before consideration of the rest of the issues by the Board.

Double Patenting

Claims 1-38 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Applicant has acknowledged this provisional double-patenting rejection and has not stated any intention to argue that the provisional rejection is improper; however, it is Applicant's intention to only file a single terminal disclaimer. This position is supported in MPEP § 804.I.B[1], which states that if the only rejections remaining in both applications are the provisional double patenting rejections, then the Examiner should withdraw the rejection in one application and permit that application to issue. The Examiner is then allowed to convert the provisional double patenting rejection to a double patenting rejection after the first application issues as a patent. After conversion, the applicant may file a terminal disclaimer to address the rejection and the second application may mature into a patent.

Applicant is waiting until the other issues have been resolved and one patent issues before providing a terminal disclaimer. In this manner, Applicant avoids paying duplicative fees for two terminal disclaimers when the relevant rules only require one.

§ 103

    A. Introduction

        1. Kirouac and Finley

---

[1] p. 800-19 in the August 2001 edition of the MPEP.

Claims 1-7, 10-16, 27, and 29-38 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac et al. (hereinafter "Kirouac") in view of Finley et al. (hereinafter "Finley"). This rejection is improper because it relies on impermissible hindsight reconstruction. Specifically, the Patent Office, in making this combination, has ignored portions of Kirouac that teach away from this sort of combination. It is only through the use impermissible selective extraction of portions of the reference that the combination can be advanced. Without the combination, the individual references do not teach or suggest all of the claim elements and thus do not render the claims obvious.

2. Kirouac, Finley and Fisher

Claims 8, 9, 17-26, and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac in view of Finley and further in view of Fisher et al. (hereinafter "Fisher"). This rejection is improper because it relies on the same combination of Kirouac and Finley. This rejection is further flawed because Fisher is non-analogous art. If a reference is not analogous, then it cannot be used to support an obviousness rejection. Without the combination of Kirouac and Finley and without Fisher, the individual references do not teach or suggest all of the claim elements and thus do not render the claims obvious.

B. Summary of the References

1. Kirouac - U.S. Patent No. 5,155,847

Kirouac is directed to a method for updating software at remote locations. To this end, copies of the software are stored in a central computer. Copies of the software on the central computer may be upgraded from time to time. The computers resident at the remote locations may periodically contact the central computer and compare the software resident at the remote location to the copy of the software that is stored in the central computer. If there is a difference, the changes are then sent to the computer at the remote location and applied to the software therein.

Kirouac is offered as a solution to intermediate-type devices. Specifically, at column 1, lines 11-42, Kirouac criticizes floppy disk distribution and tape distribution. By connecting the computers in question over the Internet, Kirouac avoids the use of intermediate type devices such as floppy disks and tapes.

5

2. Finley - U.S. Patent No. 6,442,448

Finley is a system that is designed to operate in a fueling environment. Specifically, Finley is directed to a site manager that is communicatively connected to various components within the fueling environment such as the fuel dispensers and other point of sale devices. The site manager is also connected to a remote host. The purpose of the site manager is to provide multimedia content to the fuel dispensers with an eye towards backward compatibility (see Finley, column 3, line 66-column 4, line 5).

The site manager 300 includes a service serial port 402 that may be used to connect to a service technician's laptop for diagnostics and setup (column 11, lines 32-33). Finley further describes how software in the fueling environment is upgraded.

> Any software on the DC 310 or SM 300, including any fonts, graphics, setup files, configuration or libraries could be remotely upgraded through the remote connection 400 between the SM 300 and the Wide Area Network 400. This introduces a security risk. The download may include viruses and fraudulent modules. Therefore, in the preferred embodiment, a digital signature on any down-loaded module is provided to insure the integrity of the downloaded information.

Column 6, lines 41-49. This is reinforced at column 7, lines 50-54 wherein the email client of the site manager 300 receives software upgrades. Site manager 300 also has a FLASH storage PCMCIA card 412 to store new upgrade software. This is field replaceable (column 11, lines 47-53). Nowhere is the serial port 402 linked to upgrades, despite the passage that describes the serial port 402 being in relatively close proximity to a discussion of software upgrades within the reference.

3. Fisher - U.S. Patent No. 6,247,128

Fisher relates to computer manufacturing and specifically is a system that evaluates hardware of the computer to pre-install the correct software during manufacturing of new computers (see column 1, lines 14-18). In particular, the system places software on a server and creates rule sets relating to what software is compatible with what hardware configurations and what software is compatible with other software. A new computer or hard drive is connected to the server through a download network and the software is downloaded. Diagnostics and set-up routines are then activated to test the new computer and place the new computer into a ready-to-run state (column 5, lines 20-25).

Fisher goes on to discuss a configuration list for a particular machine that can be used by a royalty tracking system 124 to ensure appropriate payment to third-party software providers. No detail as to how this is done is provided.

C. The Basic Test for Obviousness

1. The Statute

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The Interpretation

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

> Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmBH, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) (internal citations omitted). The critical inquiry in this case is the scope and content of the prior art. The first inquiry in determining the scope and content of the references is whether a reference is analogous art. If the reference is not analogous art, then the reference cannot be used in an obviousness determination. *Jurgens v. McKasy*, 927 F.2d 1552, 1559 (Fed. Cir.) *cert. denied* 502 U.S. 902 (1991). The test for analogousness is well-established at this point.

> Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the same field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

In re Clay, 966 F.2d 656, 658-59 (Fed. Cir. 1992) (citations omitted). The Federal Circuit went on to clarify:

> A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve . . . If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

Id. at 659. The question of whether a reference is analogous is a fact question. *Id.* at 658.

Once the analogous references have been identified, the hypothetical person of ordinary skill in the art is assumed to sit in a room with all the references available to him. It is well recognized that almost every invention is a combination of elements from the prior art. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). What makes an invention patentable is that it would not have been obvious to one of ordinary skill in the art to combine the references in the manner claimed. The Federal Circuit has cautioned that the references may not be gathered with the claimed invention in mind. *Pentec, Inc. v. Allen*, 776 F.2d 309, 313 (Fed. Cir. 1985). To help avoid the insidious call of hindsight reconstruction, the Federal Circuit has mandated that when the Patent Office proposes combining or modifying references, the Patent Office must articulate some reason why the combination or modification is desirable. Furthermore, this reason must be supported by evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed.Cir. 1999); *see also In re Lee*, 277 F.3d 1338, 1343-44(Fed. Cir. 2002). "That knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge." *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347 (Fed. Cir. 1999).

The Federal Circuit has further cautioned the Patent Office that it must consider the reference for all it teaches. *In re Fritch*, 972 F.2d 1260, 1264 (Fed. Cir. 1992). The Federal Circuit has indicted that the Patent Office cannot remove elements from a reference and cannot take single elements out of the reference without objective evidence. *Id*, at 1266. Further, even after combination, the combination may not be modified absent an additional showing of a suggestion of the desirability of the modification. *Id.* at 1266 (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)). Specifically, the Federal Circuit has cautioned that "one cannot use

hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Perhaps most importantly, a single line should not be taken out of context to support an obviousness determination. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986).

Once the references are properly combined, the combination must teach or suggest every element recited in the claims to establish *prima facie* obviousness. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03. "If the PTO fails to meet this burden, then the applicant is entitled to the patent." *In re Glaug*, 283 F.3 1335, 1338 (Fed. Cir. 2002).

D. The Claims are Not Obvious Over the References

1. Kirouac and Finley do not teach or suggest using a portable computing device to provide the upgrades to the remote location

Claims 1-7, 10, 11, 27, and 29-38 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac in view of Finley. At the heart of this rejection is the issue of whether it is obvious to use a portable computing device to provide upgrades to the remote location.

The Patent Office has stated in the Office Actions that Kirouac is a reference related to updating software at remote locations, but admits that Kirouac does not teach or suggest disclose downloading a software upgrade to a portable computing device and accessing a computer at a remote location with the portable computing device. The Patent Office indicates that Finley teaches accessing a remote computer using a portable computing device for the purpose of diagnostics and setup, pointing to lines 32-33 in column 11 of Finley. The Patent Office then opines that it would have been obvious to modify Kirouac "to include using a portable computing device to receive upgrades and to transfer the upgrades to the remote computer as per the teachings of Finley." (Office Action of June 2, 2003, page 10, lines 6-8). The Patent Office further opined that the motivation to do so would be "to utilize available means, such as the laptop interface of Finley to transfer data such as software upgrades."

The Patent Office clarified this motivation in the "Response to Arguments" section of the Office Action of June 2, 2003, stating that the motivation comes from the knowledge generally available to one of ordinary skill in the art. The Patent Office further indicated that one skilled in the art

9

would recognize that utilizing an already established communication means such a [sic] serial laptop interface . . . to transfer data such as the software upgrades . . . would result in reliable and efficient data transfer. In addition, by physically visiting the remote site with such a laptop computer and performing diagnostics and setup . . . additional functions could be performed such as diagnosing and fixing problems when an alternate network may be down or performing manual hardware reset to reboot an updated machine.

Office Action of June 2, 2003, page 7, lines 2-8.

Applicant initially traverses the selection of the references. It appears that the references have been selected with impermissible hindsight. Kirouac is not within the field of the fueling environment art and appears to have been selected merely because it is a software upgrade reference. Finley, which is directed to improving an internal communications network within the fueling environment by using the Home Phone Network Alliance protocol, appears to have been selected because it mentions a laptop computer. Choosing references based on individual elements violates the teachings of *Pentec*. Since the references were selected using impermissible hindsight, the rejection is not proper. Since the rejection is not proper, the claims are in a condition for allowance.

Even if the references have been properly selected, Applicant traverses the motivation to combine the references. The Patent Office, as indicated above, has stated that the motivation to combine the references is "to utilize available means, such as the laptop interface of Finley to transfer data such as software upgrades." As indicated in *Dembiczak*, the Patent Office must articulate specific findings with regards to the motivation and present evidence of this motivation. While the Patent Office indicated in the clarifying remarks that the motivation comes from the general knowledge of those of ordinary skill in the art, the Patent Office has not presented any objective evidence that supports this motivation or supports the clarifying rationale. To this extent, the Patent Office has not satisfied its burden in articulating a proper motivation to combine the reference. Since the Patent Office has not supported a proper motivation to combine the references, the combination is improper and the references individually do not establish *prima facie* obviousness. To this extent, the claims are in a condition for allowance.

Even if the Patent Office has properly supported the motivation to combine the references, Applicant further traverses the rejection on the grounds that the motivation does not compel the combination. If the motivation is to utilize means to transfer data such as software

10

upgrades, then Kirouac by itself already addresses the motivation. Kirouac uses means (such as the network) to transfer data such as software upgrades. The clarifying rationale of "Additional functions could be performed such as diagnosing and fixing problems" also does not compel using the laptop to perform software upgrades. Therefore, there is no need to combine Kirouac with Finley to address the motivation proffered by the Patent Office. Since the motivation to combine the references advanced by the Patent Office does not compel the combination of the references, the motivation to combine the references is improper. Since the motivation to combine is improper and the references individually do not show all of the claim elements, the claims are in a condition for allowance.

Applicant further appeals the motivation to combine or modify the references as contra-intuitive in light of the teachings of the references. As noted above, the Patent Office is not free to ignore teachings within the references. Kirouac specifically denigrates the use of floppy disks and tapes as being a slow, inefficient method of distribution (See Kirouac, column 1, lines 11-50). From these statements, it is readily apparent that Kirouac teaches away from any sort of intermediate device such as floppy disks, tapes, and portable computing devices. Thus, an artisan of ordinary skill in the art would not, after reading Kirouac, think to use a portable computing device to transfer the software upgrades. The clarifying rationale also ignores this teaching in Kirouac that specifically teaches away from using an intermediary device such as disks, tapes, or laptops for any purpose. Where a reference teaches away from a combination, there is no suggestion to combine a reference in an obviousness analysis. *Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). To this extent, the combination is improper. Since the combination is improper and the references do not individually show all of the claim elements, the claims are in a condition for allowance.

Even if the combination of references is proper, Applicant still further traverses this rejection on the grounds that the combination of Kirouac and Finley does not teach or suggest using the portable computing device to upgrade the software at the remote site. The combination of Kirouac and Finley results in a system that downloads software to remote sites over a network and simultaneously runs diagnostics and setup at the remote site using a portable computing device. The combination must be modified to arrive at the claimed invention. Specifically, the laptop must be modified from running diagnostics and setup routines to providing software

11

upgrades if the Patent Office is to show all the claim elements. The Federal Circuit has indicated that

> [although] couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d at 1266 (emphasis added) (citing *In re Gordon*, 733 F.2d at 902). The references fail to suggest any motivation for, or desirability of, the changes espoused by the Patent Office. Furthermore, any such motivation to modify must be supported by appropriate objective evidence. *In re Dembiczak*, 175 F.3d at 999. The Patent Office has not provided any such motivation to modify the combination and has not provided any objective evidence of from where such a motivation comes. To this extent, the Patent Office has not shown all of the claim elements and thus has not established *prima facie* obviousness. MPEP § 2143.03.

In short, the motivation to combine the references is not convincing. Even if the motivation were convincing, it is not properly supported by the required objective evidence. Even if the motivation were properly supported, the Patent Office has ignored portions of Kirouac that teach away from the combination. Even if the combination were proper, the combination does not show the claimed invention absent a modification, and the Patent Office has not offered any motivation to modify the combination. Even if the Patent Office has offered a motivation to modify the combination, the motivation is not properly supported by objective evidence. For these reasons, the Patent Office has not shown where a portable computing device is used to upgrade software at a remote location by uploading the software from the portable computing device to the remote location. Since the Patent Office has not shown where a portable computing device is used to upload software to a remote location, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, the Applicant is entitled to the patent, and Applicant requests that the Board overturn the Examiner and remand the case to Examiner for issuance of a Notice of Allowability.

2. Kirouac and Finley do not teach or suggest using a portable computing device to poll hardware and software existent at a remote fueling site

Claims 12-16 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac in view of Finley. At the heart of this rejection is the issue of whether it is obvious to use a portable

computing device to poll hardware and software existent at each of a plurality of remote fueling sites. While the arguments on this point are duplicative with the arguments presented in the preceding section, because there is a different factual inquiry as to the content of the teachings of the art, claims 12-16 stand or fall separately from claims 1-7, 10, 11, 27, and 29-38. Namely, it is possible (although Applicant does not concede this point) that the combination of Kirouac and Finley teaches or suggests using a portable computing device to provide software upgrades at a remote location while not teaching or suggesting using a portable computing device to poll hardware and software existent at each of a plurality of remote fueling sites. Likewise, the converse is possible (again, Applicant does not concede this point) in that the combination of Kirouac and Finley may teach or suggest using a portable computing device to poll hardware and software existent at each of a plurality of remote fueling sites while not teaching or suggesting using a portable computing device to provide software upgrades at a remote location. To this extent, the claims are addressed separately.

The Patent Office has stated in the Office Actions that Kirouac teaches polling hardware and software existent at a remote site and storing a plurality of records, each record relating to hardware and software configuration at different remote sites, but admits that Kirouac does not teach or suggest sending an individual equipped with a portable computing device to a plurality of remote fueling sites and using a portable computer for the step of polling. The Patent Office indicates that Finley teaches accessing a remote computer using a portable computing device for the purpose of diagnostics and setup, pointing to lines 32-33 in column 11 of Finley. The Patent Office then opines that it would have been obvious to modify Kirouac "to include sending an individual equipped with a portable computing device to remote fueling sites as part of creating, storing, and transmitting records related to fueling site hardware and software configuration as per the teachings of Finley." (Office Action of June 2, 2003, page 12, lines 3-7). The Patent Office further opined that the motivation to do so would be "to utilize available means, such as the laptop interface of Finley for configuration monitoring at fueling cites that contain computer hardware and software." Unlike claim 1, the Patent Office did not offer any clarifying remarks directly addressing claim 12.

Applicant initially traverses the selection of the references. It appears that the references have been selected with impermissible hindsight. Kirouac is not within the field of the fueling environment art and appears to have been selected merely because it is a software upgrade

reference. Finley, which is directed to improving an internal communications network within the fueling environment by using the Home Phone Network Alliance protocol, appears to have been selected because it mentions a laptop computer. Choosing references based on individual elements violates the teachings of *Pentec*. Since the references were selected using impermissible hindsight, the rejection is not proper. Since the rejection is not proper, the claims are in a condition for allowance.

Even if the references have been properly selected, Applicant traverses the motivation to combine the references. The Patent Office, as indicated above, has stated that the motivation to combine the references is "to utilize available means, such as the laptop interface of Finley for configuration monitoring at fueling cites that contain computer hardware and software." As indicated in *Dembiczak*, the Patent Office must articulate specific findings with regards to the motivation and present evidence of this motivation. The Patent Office has not identified from where the motivation to combine the references comes, nor has the Patent Office presented any objective evidence that supports this motivation. To this extent, the Patent Office has not satisfied its burden in articulating a proper motivation to combine the references. Since the Patent Office has not articulated and supported a proper motivation to combine the references, the combination is improper and the references individually do not establish *prima facie* obviousness. To this extent, the claims are in a condition for allowance.

Even if the Patent Office has properly supported the motivation to combine the references, Applicant further traverses the rejection on the grounds that the motivation does not compel the combination. If the motivation is to utilize means to monitor configurations at remote fueling sites, then Kirouac by itself already addresses the motivation. Kirouac uses means (such as the network) to perform this monitoring. Therefore, there is no need to combine Kirouac with Finley to address the motivation proffered by the Patent Office. Since the motivation to combine the references advanced by the Patent Office does not compel the combination of the references, the motivation to combine the references is improper. Since the motivation to combine is improper and the references individually do not show all of the claim elements, the claims are in a condition for allowance.

Applicant further appeals the motivation to combine or modify the references as contra-intuitive in light of the teachings of the references. As noted above, the Patent Office is not free to ignore teachings within the references. Kirouac specifically denigrates the use of floppy disks

and tapes as being a slow, inefficient method of distribution and communication (see Kirouac, column 1, lines 11-50). From these statements, it is readily apparent that Kirouac teaches away from any sort of intermediate device such as floppy disks, tapes, and portable computing devices. Thus, an artisan of ordinary skill in the art would not, after reading Kirouac, think to use a portable computing device to transfer the software upgrades. Where a reference teaches away from a combination, there is no suggestion to combine a reference in an obviousness analysis. *Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). To this extent, the combination is improper. Since the combination is improper and the references do not individually show all of the claim elements, the claims are in a condition for allowance.

Even if the combination of references is proper, Applicant still further traverses this rejection on the grounds that the combination of Kirouac and Finley does not teach or suggest using the portable computing device to poll the hardware and the software at the remote fueling site. The combination of Kirouac and Finley results in a system that polls hardware and software at remote sites over a network and simultaneously runs diagnostics and setup at the remote site using a portable computing device. The combination must be modified to arrive at the claimed invention. Specifically, the laptop must be modified from running diagnostics and setup routines to polling hardware and software if the Patent Office is to show all the claim elements. The Federal Circuit has indicated that

> [although] couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious <u>unless the prior art suggested the desirability of the modification.</u>

In re Fritch, 972 F.2d at 1266 (emphasis added) (citing *In re Gordon*, 733 F.2d at 902). The references fail to suggest any motivation for, or desirability of, the changes espoused by the Patent Office. Furthermore, any such motivation to modify must be supported by appropriate objective evidence. *In re Dembiczak*, 175 F.3d at 999. The Patent Office has not provided any such motivation to modify the combination and has not provided any objective evidence of from where such a motivation comes. To this extent, the Patent Office has not shown all of the claim elements and thus has not established *prima facie* obviousness. MPEP § 2143.03.

In short, the motivation to combine the references is not convincing. Even if the motivation were convincing it is not properly supported by the required objective evidence.

Even if the motivation were properly supported, the Patent Office has ignored portions of Kirouac that teach away from the combination. Even if the combination were proper, the combination does not show the claimed invention absent a modification, and the Patent Office has not offered any motivation to modify the combination. Even if the Patent Office has offered a motivation to modify the combination, the motivation is not properly supported by objective evidence. For these reasons, the Patent Office has not shown where a portable computing device is used to poll hardware and software existent at the remote fueling sites. Since the Patent Office has not shown where a portable computing device is used to upload software to a remote location, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, the Applicant is entitled to the patent and Applicant requests that the Board overturn the Examiner and remand the case to Examiner for issuance of a Notice of Allowability.

3. Fisher is non-analogous, and even if Fisher is analogous, the combination of references is still improper

Claims 8, 9, 17-26, and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac in view of Finley and further in view of Fisher. Applicant appeals this rejection on the grounds that Fisher is non-analogous art. Even if Fisher is analogous art, Fisher does not cure the problems with the combination of Kirouac and Finley.

The test for analogousness is set forth above, but is repeated here for convenience. Specifically, the reference must be in the same field of endeavor or reasonably pertinent to the particular problem with which the inventor was involved. *In re Clay*, 966 F.2d at 658-59. Fisher is not within the same field of endeavor as the present invention. Fisher is directed to computer manufacturing, not software upgrading. To this extent, Fisher fails the first prong of the analogousness test. Fisher is likewise not reasonably pertinent to the particular problem with which the inventor was involved. The inventor of the present invention was involved with a problem of getting accurate records of hardware and software at remote fueling sites and particularly was involved with tracking what Authorized Service Contractors did at the various remote fueling sites. When someone of ordinary skill in the art is involved in this problem, it is not logical that a computer manufacturing reference would commend itself to the inventor. Specifically, Fisher is directed to a different purpose - optimizing installation of software on variously configured new computers that need to be shipped in a ready to use configuration.

16

Because Fisher is directed to a different purpose, *In re Clay* indicates that the reference is not reasonably pertinent. Since the reference is not reasonably pertinent, the reference fails the second prong of the analogousness test.

In response to Applicant's initial arguments that Fisher was non-analogousness, the Patent Office indicated in the Advisory Action of July 23, 2003 that

> Fisher is relied upon as teaching accessing a central computer in order to properly account for royalties due following software installation. As Applicant's invention is also directed toward software installation in which royalties may be due, the Fisher reference is considered reasonably pertinent to the particular problem with which the inventor was concerned.

Advisory Action of July 23, 2003, continuation page, lines 5-9. However, this overgeneralizes the problem with which the inventor was concerned and overgeneralizes the problem with which the Fisher reference addresses. The primary problem with which the present invention is concerned is upgrading software at fueling environments. Secondary to that is a concern regarding accounting for these upgrades. Fisher is concerned with computer manufacturing and specifically with selecting software for pre-installation (see abstract and columns 1-6 of Fisher). The reference within Fisher to accounting is buried in column 12, lines 50-55, and thus is clearly not a problem specifically addressed by Fisher. As noted above, Fisher is thus directed to a different purpose, and that is evidence that Fisher fails the second prong of the analogousness test.

Having failed both prongs of the analogousness test, the reference is non-analogous. Since the reference is non-analogous, the reference may not be used in an obviousness determination. Since the reference may not be used in an obviousness determination, and the Patent Office admits that Kirouac and Finley do not teach or suggest all the claim elements of claims 8, 9, 17-26, and 28, the Patent Office has not established *prima facie* obviousness with respect to these claims, and the claims are in a condition for allowance.

To the extent that claims 8 and 9 depend from claim 1 and claim 28 depends from claim 27, if the issue of analogousness is decided against Applicant, claims 8, 9 and 28 stand or fall with claim 1. However, because Fisher is non-analogous, claims 8, 9, and 28 are separately patentable from claim 1 and stand in condition for allowance.

Claim 17 recites, in relevant part, providing software upgrades on a portable computing device and upgrading computers at a remote location. To this extent, claim 17 is analogous with

17

claim 1 and, if the issue of analogousness is decided against Applicant, claims 17-26 stand or fall with claim 1. However, because Fisher is non-analogous, claims 17-26 are separately patentable from claim 1 and stand in condition for allowance.

Because Fisher is non-analogous, claims 8, 9, 17-26, and 28 are not properly rejected by the combination of Kirouac, Finley, and Fisher, and stand in a condition for allowance.

Conclusion

For the reasons articulated above, Applicant requests that the Board overturn the Examiner and remand the case to the Examiner with instructions to issue the Notice of Allowability.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

Steven N. Terranova
Registration No. 43,185
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: October 29, 2003
Attorney Docket: 2400-418

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST-CLASS MAIL, IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, PO BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450, ON OCTOBER 29, 2003.

Kelly Farrow
Name of Depositor

_____
Signature

10/29/03
Date of Signature

(9) APPENDIX

1. (Currently Pending) A method of upgrading software a location remote from a corporate computer comprising:

downloading a software upgrade from the corporate computer to a portable computing device;

accessing a computer at a remote location with said portable computing device; and

uploading said software upgrade to said computer at said remote location.

1. (Proposed Amendment) A method of upgrading software to a location remote from a corporate computer comprising:

downloading a software upgrade from the corporate computer to a portable computing device;

accessing a computer at a remote location with said portable computing device; and

uploading said software upgrade to said computer at said remote location.

2. (Original) The method of claim 1 wherein said remote location comprises a fueling site.

3. (Original) The method of claim 1 further comprising storing a record indicative of a quantity of upgrades performed.

4. (Original) The method of claim 1 further comprising downloading said software upgrade from said computer to a peripheral device.

5. (Original) The method of claim 1 further comprising determining a hardware and software configuration at said remote location.

6. (Original) The method of claim 5 further comprising storing a record indicative of said hardware and software configuration.

7. (Original) The method of claim 6 further comprising subsequently providing said record indicative of said hardware and software configuration to said corporate computer.

8. (Original) The method of claim 1 further comprising subsequently accessing said corporate computer to secure an accounting for upgrades installed.

9. (Original) The method of claim 8 further comprising accounting for royalties due a third party based on said upgrades installed.

10. (Original) The method of claim 7 further comprising compiling a database of a plurality of records indicative of said hardware and software configurations.

11. (Original) The method of claim 1 wherein accessing a computer comprises accessing a site controller at a fueling site.

12. (Original) A method of generating a database of fueling site configurations, comprising:

   sending an individual equipped with a portable computing device to a plurality of remote fueling sites;

   polling with said portable computing device, hardware and software existent at each of said remote fueling sites;

   storing a plurality of records, each of said records relating to different ones of said remote fueling sites, said record detailing the fueling site configuration including hardware and software; and

   uploading to a corporate computer said plurality of records.

13. (Original) The method of claim 12 further comprising providing a portable computing device to said individual.

14. (Original) The method of claim 12 wherein uploading to a corporate computer comprises uploading to said corporate computer through a web based interface.

15. (Original) The method of claim 12 wherein polling comprises polling through a site controller.

16. (Previously Amended) The method of claim 12 further comprising generating a database from said plurality of records and generating recommendations as to potential upgrades from said database.

17. (Original) A method of tracking payment obligations comprising:

    providing software upgrades on a portable computing device;

    directing said portable computing device to a remote location;

    accessing with said portable computing device a computer at said remote location;

    upgrading one or more software components of one or more computers at said remote location;

    storing a record of any upgrades provided; and

    uploading said record to a corporate computer for determination of payment obligations

18. (Original) The method of claim 17 wherein said payment obligations comprise royalty obligations.

19. (Original) The method of claim 17 wherein said payment obligations comprise commissioning obligations.

20. (Original) The method of claim 17 further comprising accounting for said payment obligations.

21. (Original) The method of claim 17 wherein directing said portable computing device to a remote location comprises directing said portable computing device to a remote fueling site.

22. (Original) The method of claim 17 wherein storing a record of any upgrades provided comprises storing a version number associated with each of said any upgrades.

23. (Original) The method of claim 17 wherein storing a record of any upgrades provided comprises storing a number of upgrades provided.

24. (Original) The method of claim 17 wherein storing a record of any upgrades provided comprises storing a version number associated with software existent prior to said upgrade.

25. (Original) The method of claim 17 further comprising determining if said upgrading resulted from a warranty contract.

26. (Original) The method of claim 25 further comprising accounting for said fueling site if said upgrading fell outside of any warranty contract obligation.

27. (Original) A portable computing device comprising software adapted to

communicate with a corporate computer and download therefrom a software upgrade package;

communicate with a computer at a remote location and install one or more of said software upgrade packages;

poll said computer at said remote location to determine a hardware configuration and a software configuration at said remote location; and

record indicia relating to a number of software upgrade packages installed.

28. (Original) The portable computing device of claim 27 wherein said software is further adapted to communicate said recorded indicia to said corporate computer for the purpose of facilitating an accounting therefrom.

29. (Original) The portable computing device of claim 27 wherein said software is further adapted to install a patch to enable functioning of said software upgrade package on said · computer at said remote location.

30. (Original) A system for upgrading software at remote fueling sites, comprising:

a portable computing device;

a corporate computer including means for downloading to said portable computing device, said downloading means transferring a software upgrade to said portable computing device;

a remote fueling site including a site controller, said site controller including means to upload said software upgrade from said portable computing device; and

wherein said portable computing device includes means for determining a hardware and software configuration at said remote fueling site, means for recording said configuration; and means to transfer said configuration to said corporate computer.

31. (Original) The system of claim 30 wherein said portable computing device further includes means for recording commission related data based on a number of software upgrade installations performed by said portable computing device.

32. (Original) A system for upgrading software at remote fueling sites, comprising:

a portable computing device;

a corporate computer including means for downloading to said portable computing device, said downloading means transferring a software upgrade to said portable computing device; and

wherein said portable computing device includes means to transfer said software upgrade to a device at a remote fueling site.

33. (Original) The system of claim 32 wherein said portable computing device is a laptop computer.

34. (Original) The system of claim 32 wherein said portable computing device is a personal digital assistant.

35. (Original) The system of claim 32 wherein said portable computing device further includes means for determining upgrades needed at the remote fueling site.

36. (Original) The system of claim 35 wherein said determining means comprises communications means for accessing the corporate computer.

37. (Original) The system of claim 32 wherein said transferring means is adapted to communicate with a site controller at the remote fueling site.

38. (Original) The system of claim 32 wherein said transferring means is adapted to communicate with a fuel dispenser at the remote fueling site.